

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHIAS MULLER and GUNTER BAUER

Appeal 2007-1448
Application 10/601,325
Technology Center 3600

Decided: June 26, 2007

Before FRED E. McKELVEY, *Senior Administrative Patent Judge*, and
HUBERT C. LORIN, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-7, and 11-13. Claims 9 and 10 are withdrawn from consideration. Claims 8, 14-19 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants are said to have invented a holding clip for fixing the position of getters in containers of random diameter in closed vacuum systems, especially collector tubes. (Specification 1)

Claim 1, reproduced below, is representative of the subject matter on appeal (drawing element numbers from Figs. 1 and 3 added; Figs. 1 and 3 from the Specification are reproduced below).

1. A holding clip [Fig. 1 and Fig. 3 1] for fixing the position of a getter [Fig. 3 16] in an inner surface [Fig. 3 20] of a container, comprising:

a first section [Fig. 1 and Fig. 3 2] for supporting the getter;

a second section [Fig. 1 and Fig 3 4] for supporting said first section in the inner surface of the container; and

a flexurally rigid connection [Fig. 1 13/14] connecting said first and second sections, wherein said flexurally rigid connection and said first and second sections are elastically deformable to brace the getter in said first section and said second section in said inner surface.

Fig. 1 from the Specification is reproduced below.

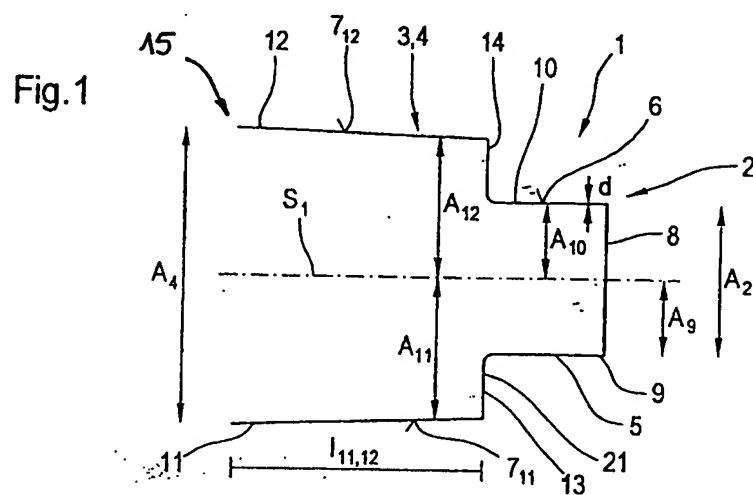


Fig. 1

Fig. 1 is a view of a schematically simplified representation the holding clip.

Fig. 3 from the Specification is reproduced below.

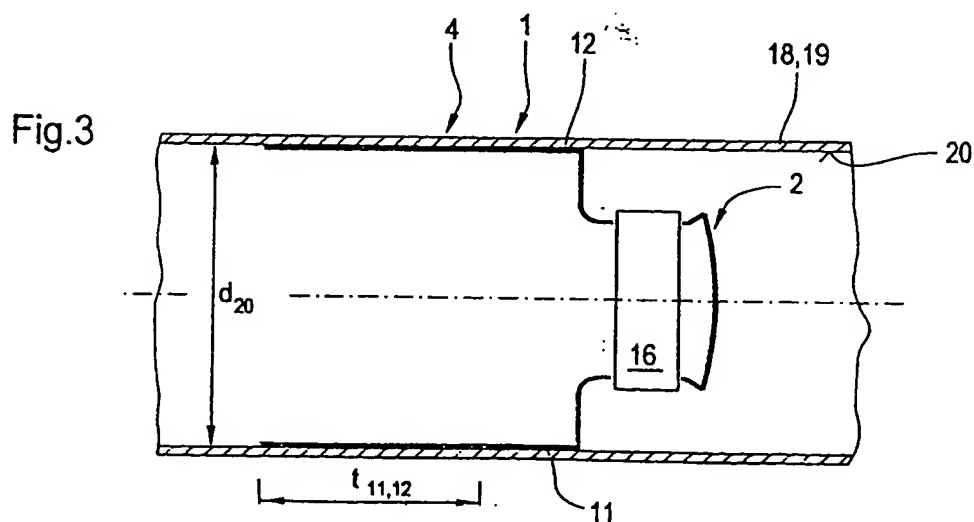


Fig. 3

Fig. 3 is a view showing the clip carrying a getter in a state held in the container.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Pohle	US 2,575,835	Nov. 20, 1951
Misono	US 4,374,344	Feb. 15, 1983
Shaffer	US 5,717,290	Feb. 10, 1998

In addition to the evidence relied upon by the Examiner, we rely on the following additional patent:

Wisniewski	US 5,722,124	Mar. 03, 1998
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The following rejections are before us for review.

Claims 1-7, 11-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pohle (US 2,575,835) in view of Misono et al. (US 4,374,344).

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Pohle (US 2,575,835) in view of Misono et al. (US 4,374,344) as applied to claim 1 and further in view of Shaffer (US 5,717,290).

ISSUE

Appellants contend the Examiner erred in rejecting claims 1-7, 11-13 using Pohle in view of Misono because (1) there is no motivation, suggestion or teaching to combine, and (2) even if properly combined, these references still fail to account for all the claimed elements. The Examiner, however, held it would have been obvious to one with ordinary skill in the art to modify Pohle to result in the claimed combination based upon the teachings of Misono.

The issue before us is whether Appellants have sustained their burden of showing that the Examiner erred in rejecting the claims on appeal as being unpatentable under 35 U.S.C. § 103(a) over Pohle in view of Misono.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Pohle discloses a holding clip 18 for fixing the position of a getter (Pohle, col.1, ll. 9, 21) within an inner surface 17 of a container 11.
2. Pohle discloses a first section of the clip 18 having fingers 26 for supporting the getter 14 thereon (Pohle col. 2 ll. 23-29).
3. Pohle discloses a second section of the clip 18 comprising legs 22 biased against the inner surface of the container for supporting the first section and the getter within the container. (Pohle col. 1, 50-55, col.2 ll. 1-4).
4. Pohle discloses the legs 22 of the clip 18 being bent first up then out then down giving the connection at the up and out juncture a generally rigid right angle formation, which according to Fig. 1 showing the clip 18 in the inserted condition, shows the up and out juncture maintained at a generally rigid right angle.
5. Pohle thus discloses a flexurally rigid connection connecting said first and second sections at the right angle juncture between the bent up and then out portions of the legs 22 while in the inserted condition of the tube 11. (Pohle Fig. 1).

6. Pohle discloses the flexurally rigid connection and second section are elastically deformable to brace the clip to the inner surface of the container 11. (Pohle, col.1, ll. 50-55, col.2 ll.1-4, Fig. 1).
7. Misono also discloses a flexurally rigid connection at the creased legs 7 of the conductive spacer 7, but the spacer is “secured” and not braced to the electron gun. (Misono, col.1, ll. 40)
8. Wisniewski discloses a holding clip 10 having a first section defined by one or more of radially inwardly angled portions 24, 24 which are elastically deformable (col. 5 ll. 56-59) to receive a connected member therein.
9. Wisniewski discloses a holding clip 10 having a second section defined by resilient portions 26, 28, 30, and 32 which press against an inner surface of opening 90 to create a circumferential bias to support the clip therewithin. (Wisniewski, col. 3, ll. 64, col. 5 ll. 40-54).

PRINCIPLES OF LAW

A claimed invention is not patentable if the subject matter of the claimed invention would have been obvious to a person having ordinary skill in the art. 35 U.S.C. § 103(a); *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741-42, 82 USPQ2d 1385, 1397 (2007). *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 466-67 (1966).

Facts relevant to a determination of obviousness include (1) the scope and content of the prior art, (2) any differences between the claimed invention and the prior art, (3) the level of skill in the art, and (4) any relevant objective evidence of obviousness or non-obviousness. *Graham*, 383 U.S. at 17-18, 148 USPQ at 466-67.

The application of common sense may control the combining of references.

Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.

KSR, 127 S.Ct. at 1742, 82 USPQ2d at 1397 (finding that during an obviousness determination, the person of ordinary skill's attempt to solve a problem is not limited to only those elements of the prior art designed to solve the same problem).

ANALYSIS

We begin our analysis by construing claim 1, and specifically the term "brace." Reading the claim in light of the specification as interpreted by one of ordinary skill (see *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)), we construe the phrase "a flexurally rigid connection connecting said first and second sections, wherein said flexurally rigid connection and said first and second sections are elastically deformable to brace

the getter in said first section and said second section in said inner surface” to mean that the clip acts on the getter by a non-positive connection. (Specification 10:18) Further, page 12, lines 5-8 of the Specification describes the relationships between the clip and the container, and between the clip and the getter as one which “braces” not only the clip in place in the container, but also “braces” the getter in the clip by the elastic forces acting on it by the second and first sections, respectively.

Pohle shows a spider 18 which supports a gettering loop 19 within a container using circumferentially disposed spring legs 22 to mount the clip to the container. The legs 22 of Pohl’s spider 18 ultimately support the getter in the inner surface of the container. (Finding of Fact 3) The spider includes fingers 26 which do the actual supporting of the getter. (Finding of Fact 2) Therefore, legs 22 correspond to the second section of the claimed clip and fingers 26 correspond to the first section.

That leaves only the question of whether Pohl shows a flexurally rigid connection between the two sections such that they are “elastically deformable to brace the getter in said first section and [brace the] second section in said inner

surface” as required by claim 1. In that regard, the gettering loop is attached to the spider through a *positive* connection e.g., welding (see col. 2, line 27), at the support finger(s) 26 of the spider 18, and not by *bracing* the loop into place using the elastic deformation force of the clip in the manner claimed.

Misono is equally deficient in this regard in that the legs 7 of the conductive spacer 7, are “secured” and not braced to the electron gun. (Finding of Fact 7).

Accordingly, we agree with Appellants that the combination of Pohle and Misono fail to teach a flexurally rigid connection “sufficient to both brace a getter in the first section and brace a second section in the inner surface by the elastically deformable nature of a flexurally rigid connection, a first section, and a second section as claimed.” (Emphasis original) (Br. 6) While the Examiner reasonably interpreted the term “brace” as the pressure connection between the outwardly biased legs 22 and the inner wall of the container 11 in Pohle, Pohle does not fairly suggest “bracing” the getter in the clip.

Notwithstanding the deficiencies of Pohl and Misono, we reject claims 1-7, 11-13 under 35 U.S.C. §103(a) as being unpatentable over Pohle in view of Wisniewski. Appellants’ only challenge to Pohle is that it “discloses a gettering

loop 19 secured to the outer end of finger 26 in any suitable manner as for instance welding. Alternately, getting loop 19 is secured to the skirt portion 25.” (Br. 4)
We find this difference in Pohle to be overcome by the teachings in Wisniewski.

Elastically deformable portions of a clip which hold another member in place on it were known at the time of the invention. One example of this is the biasing portions or fingers 24 of the clip 10 in Wisniewski which hold shaft 84 in place within the clip 10.

The clip 10 in Wisniewski is similar to Appellants’ in that it has two biasing sections each respectively responsible for: 1. holding the clip to a mounting member (76), and 2. holding a mounted member (84) to the clip using only the biasing force of the clip. This is respectively accomplished in Wisniewski by:
1. the radially disposed outwardly biased portions 26, 28, 30 and 32 which press outwardly against a juxtaposed cylindrical surface of the mounting opening 90 to hold the clip in place therein, and 2. the centrally disposed biasing portions or fingers 24, 24 of the clip 10 which hold the mounted shaft 84 in place within the clip 10.

Both Appellants' device and that of Wisniewski deal with a biasing problem in a clip designed to hold a member in place on the clip using only the inherent biasing force of the clip material. "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR* at 1742. Thus, to hold the gettering loop in Pohle in place using the resilient bias of its support legs 26 rather than by a connection weld, as taught by Wisniewski at biasing portions 24, 24, would have been an obvious modification because at the time of the invention, using the radial bias of a portion of a clip to hold another element on the clip was known, as evidenced by Wisniewski.

The Appellants do not provide a convincing argument as to the separate patentability of claims 2-7, 11-13 that depend from claim 1, which is the sole independent claim among those claims.¹ Therefore, claims 2-7, 11-13 fall with claim 1. *See*, 37 C.F.R. § 41.37(c)(1)(vii)(2004).

¹ Appellants explicitly state "[c]laims 1 through 7 and 11 through 13 stand or fall together" (Br.4) Claim 12 was rejected separately under 35 U.S.C. § 103(a) with the additional reference to Shaffer, but Appellants did not direct any separate merits argument to it. (Br.8)

In the event of further prosecution, Appellants are free to argue independent patentability of the dependent claims, but nothing in this opinion precludes the Examiner from rejecting any other claim in this case in response to such arguments.

CONCLUSIONS OF LAW

The decision of the Examiner to reject the claims on appeal under 35 U.S.C. § 103(a) over prior art is affirmed.

Since we use Wisniewski instead of Misono, we designate our affirmance as a new rejection. 37 C.F.R. § 41.50(b) (2006).

On the record before us, the Appellants are not entitled to a patent claiming rejected claims 1-7, and 11-13 on appeal.

Our decision is not a final agency action.

Bd. R. 41.50(b) [37 CFR § 41.50 (b) 2006)] provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to a new ground of rejection:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

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DECISION

Upon consideration of the appeal, and for the reasons given,

ORDERED that the decision of the examiner rejecting claims 1-7 and 11-13 is affirmed.

FURTHER ORDERED that since our rationale differs from the rationale of the examiner, our affirmance is designated as a new ground of rejection under 37 CFR § 41.50(b) (2006).

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED
(37 CFR § 41.50(b) (2006))

vsh

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